

ATTORNEY DOCKET NO
509854.500172

PATENT
U.S. 10/706,014

Remarks/ Arguments

In response to the Office Action mailed July 11, 2007, Applicants respectfully request that the Examiner reconsider the rejections of the claims.

Claims 1-5, 7-10, 12-15, and 17-20 remain.

Claims 1, 7, 15, and 19 are being amended.

Claim 19 has been amended to correct informalities.

Claims 1-5, 7-10, 12-15, and 17-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Kikuchi et al.* (U.S. Patent Application 2003/0147629) (hereinafter "*Kikuchi*"). Applicants respectfully traverse these rejections.

Applicants have amended independent Claims 1, 7, and 15 to include the limitations of previously presented dependent claims 6, 11, and 16, which have now been cancelled. The following remarks are made on the basis of these amendments.

Anticipation rejections under 35 U.S.C. § 102(e) require identity of invention. In other words, the Examiner has the burden of identifying, *prima facie*, each and every feature of each and every claim rejected as anticipated in a single prior art reference. The Examiner has failed to meet this burden with regards to the anticipation rejections of Claims 1-5, 7-10, 12-15, and 17-20.

With regards to Claims 1-5, *Kikuchi* clearly does not teach the ability of an end-user to generate a background image using imported data, particularly data imported in a format selected from the group consisting of Joint Picture Experts Group, Graphic Interchange File, Bitmap, and Moving Pictures Experts Group formats.

The Examiner correctly submits that the menu background information in *Kikuchi* is selected from read-only memory (ROM). Hence, while the end-user can select a different background, the end-user has no ability to generate their own background since, by definition, information in ROM is fixed. It appears that these selectable

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backgrounds are limited to patterns similar to those used on computer screens, as shown in Figure 68.

Furthermore, Applicants respectfully note that the assertion by the Examiner on Paragraph 5 of Page 3 of the Office Action, that Paragraph [0447] of *Kikuchi* teaches generating a background using imported data, particularly data imported in a format selected from the group consisting of Joint Picture Experts Group, Graphic Interchange File, Bitmap, and Moving Pictures Experts Group formats, is incorrect. Paragraph [0447] of *Kikuchi*, which must be read in connection with preceding Paragraph [0446], instead describes the generation of the *menu thumbnails*:

[0446] In this case, packets of thumbnail pictures used in the user menu are transferred to and temporarily saved in memory 59 for storing thumbnail pictures. The size of each thumbnail picture on the user menu is selected to be, e.g., approximately 144 pixels.times.96 pixels.

[0447] In the arrangement shown in FIG. 40, MPEG2 compression, which is the same as the compression format of main picture data, *can be used as that of thumbnail pictures*, but other compression schemes may be used. For example, other compression schemes such as JPEG compression, runlength compression (pallet 2.56 colors: requires a reduction to 256 colors), TIFF format, PICT format, and the like can be used. (Emphasis added)

With further regards to Claims 7 – 10, Applicants respectfully submit that *Kikuchi* never discusses generating a menu by decompressing data, operating on those data in the decompressed space to generate a menu, compressing the menu, and then re-recording the generated menu on to the disk. The Examiner cites FIGURE 68 cites as teaching these features; however, the flow charts (Figs. 60 and 61) and the associated text beginning on Paragraph [0701] never discuss this or a similar set of operations. (In fact a computer search of the Detailed Description of *Kikuchi* reveals that the term "decompression" is never even used.)

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The same is true with system Claims 15, and 17 – 20; the *Kikuchi* does not teach systems in which an end-user can generate a menu by operating on data in a decompressed space.

Given the substantial differences between Claims 1-5, 7-10, 12-15, and 17-20, and the teachings of the *Kikuchi* reference, Applicants respectfully submit that the Examiner has not met his burden of proving a *prima facie* case of anticipation, and therefore that the rejections of Claims 1-5, 7-10, 12-15, and 17-20 should be withdrawn.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kikuchi*. Applicants respectfully traverse this rejection on the same grounds discussed above with regards to associated independent Claim 7.

No new matter has been added; the claims have been merely amended to more particularly claim the subject matter Applicants believe is inventive. Applicants respectfully submit that the Claims as they now stand are patentably distinct over the art cited during the prosecution thereof.

With the addition of no new claims, no additional filing fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account Number 20-0821 of Thompson & Knight LLP.

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If the Examiner has any questions or comments concerning this paper or the present application in general, the Examiner is invited to call the undersigned at (214) 969 - 1749.

Respectfully submitted,

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